

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
February 22, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Dharmacon, Inc.

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Serial No. 85041732

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Michael D. Fishman and Michelle L. Visser of Rader, Fishman & Grauer PLLC for
Dharmacon, Inc.

Angela Micheli, Trademark Examining Attorney, Law Office 101 (Ronald R.
Sussman, Managing Attorney).

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Before Holtzman, Kuczma, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On May 18, 2010, applicant Dharmacon, Inc. applied to register SHMIMIC,
in standard character form, on an intent-to-use basis pursuant to Trademark Act
Section 1(b), 15 U.S.C. § 1051(b), for goods ultimately identified as:

Research support reagents, namely, reagents for use in
scientific, genetic and medical research; reagents
containing nucleic acids exhibiting microRNA activity
when transfected into mammalian cells in tissue culture
for laboratory use.

in International Class 001.¹

The examining attorney has refused registration on the ground that the applied-for mark merely describes the purpose or function of applicant's goods pursuant to Trademark Action Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

Applicant has appealed and requested reconsideration, which was denied. The appeal is fully briefed.

Analysis

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term is used, and the possible significance that the term is likely to have to the average purchaser encountering the goods or services in the marketplace. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Engineering Sys. Corp.*, 2 USPQ2d 1075, 1076 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows

¹ Application Serial No. 85041732.

what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

While a combination of descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968), the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *See, e.g., In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Tower Tech, Inc.*, 64 USPQ2d at 1317-18 (SMARTTOWER merely descriptive of commercial and industrial cooking towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1088 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs). The fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983). Further, the fact that other words or phrases exist for competitors to use does not redeem an otherwise merely descriptive word or phrase.

The examining attorney contends that the applied-for mark, SHMIMIC, immediately and unequivocally describes the purpose, function, and nature of

applicant's goods. This position is based on record evidence demonstrating that SH is an acronym recognized in the reagent and nucleic acid field designating "small hairpin" or "short hairpin" RNA, a sequence of RNA that makes a tight hairpin turn that can be used to silence gene expression via RNA interference.² Mimics, in turn, "are artificially created RNA designed to mimic the specific miRNA that the researcher desires."³ Thus, the examining attorney contends, the MIMIC portion of applicant's mark names the category of goods of which applicant's goods are part. The examining attorney argues that SHMIMIC "is not suggestive of the applicant's goods, because the term immediately identifies that the goods are small or short hairpin mimics."⁴ She points out that RNA researchers familiar with short or small hairpin RNA and with mimics are the potential purchasers of applicant's highly specialized goods, and contends that such researchers "would immediately know

² Examining attorney's brief at unnumbered pages 2-3; *see, e.g.*, January 4, 2011 Office action at unnumbered p. 4 and 6 (screenshots from Santa Cruz Biotechnology, Inc. website www.scbt.com stating that "shRNA refers to small hairpin or short hairpin RNA"), 13 (screenshot of an article on www.ncbi.nlm.nih.gov, website of the National Center for Biotechnology Information, referencing "short-hairpin RNAs (shRNAs)"), and 51 (screenshot of a Wikipedia.com entry on small hairpin RNA using the acronym shRNA); August 12, 2011 Office action at unnumbered p. 7 (screenshot from www.plantsci.cam.ac.uk, website of the University of Cambridge Department of Plant Sciences, titled "Short-hairpin (sh)RNA"); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (finding that information originating on foreign websites can carry some probative value); *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007) (accepting Wikipedia evidence when corroborated with other reliable sources).

³ Examining attorney's brief at unnumbered p. 3; January 4, 2011 Office action at unnumbered p. 48 (screenshot from Insight Genomics website, www.insightgenomics.com, offering "high-quality reagents for less" and referencing miRNA mimic reagents).

⁴ Examining attorney's brief at unnumbered p. 3.

what the components of the proposed mark signify, a small hairpin artificially created RNA.”⁵

Applicant admits the record evidence shows that “SH” may be an abbreviation for “small hairpin,” “short hairpin,” or “simple hairpin”; that this abbreviation may be used in association with RNA (e.g., as “shRNA,” a sequence of RNA that makes a tight hairpin turn); and that a “mimic” is an artificially created molecule designed to imitate the function of another molecule, including both RNA and other types of molecules.⁶ Nonetheless, applicant notes that there is no record evidence suggesting an association between “SH” and “MIMIC.”⁷ Any relationship between the two portions of its mark “is only by virtue of the term ‘RNA,’ which may give these two terms context. This is missing in this case, and it would be missing in the minds of consumers.”⁸ Applicant contends that SHMIMIC is a unitary and inherently distinctive term, “a unique and catchy mark that performs the function of distinguishing Applicant’s goods.”⁹ Applicant analogizes its mark to the terms “high school curriculum” and “ribonucleic acid” (RNA), which become meaningless – or at least without immediate significance – if the middle term is omitted, leaving

⁵ *Id.* at unnumbered p. 6.

⁶ Applicant’s Brief at 6, 9; Reply Brief at 1. In fact, in response to a request for information about the significance of the wording in SHMIMIC, applicant stated: “Within the reagent or nucleic acid trade or industry, the term ‘SH’ indicates molecules forming a small hairpin. Within the same industry, the term ‘MIMIC’ may be used for reagents that simulate the activity of a naturally occurring biological material. When reagents are used as mimics and are inserted into a cell, they may silence certain genes to varying degrees.” October 15, 2010 Response to Office Action.

⁷ Reply Brief at 1.

⁸ *Id.*

⁹ Applicant’s Brief at 10.

“high curriculum” and “ribo acid,” respectively.¹⁰ Combining the two formatives SH and MIMIC into the mark SHMIMIC “results in a term that is not immediately descriptive due to the many connotations of the individual formatives of the mark,” applicant contends.¹¹

We do not agree with applicant that its mark necessarily “looks like a single word and sounds like a single word,” rather than a composite combining “SH” and “MIMIC.”¹² Descriptiveness must be determined from the perspective of the relevant class of purchasers for applicant’s goods. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The perception of the relevant purchasing public sets the standard for determining descriptiveness.”). The scientific and medical research professionals who would be the purchasers of applicant’s reagents would immediately recognize SHMIMIC as simply a combined form of the two descriptive terms SH MIMIC, and they would readily understand the descriptive meaning of the term as a whole in relation to applicant’s products. Furthermore, we note that, because applicant seeks registration in standard character form, it may present its mark as “shMIMIC,” as it in fact appears in the record evidence in association with applicant’s goods, emphasizing the descriptive nature of the individual components.¹³

¹⁰ Reply Brief at 2.

¹¹ Applicant’s Brief at 9.

¹² *Id.* at 8.

¹³ *See* January 4, 2011 Office action at unnumbered p. 53.

Applicant also argues that the missing term “RNA” and the fact that its goods are reagents, rather than RNA mimic molecules themselves, requires a “mental pause” on the part of consumers.¹⁴ We reiterate, however, that we must consider applicant’s mark in relation to its goods, which include “reagents containing nucleic acids exhibiting microRNA activity.” In this context, SHMIMIC would advise consumers that applicant’s goods contain shRNA mimics. Moreover, a term need not immediately convey an idea of each and every specific feature of the applicant’s goods in order to be considered merely descriptive; it is enough that the term describes one single, significant feature or attribute. *See In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the full scope and extent of the applicant’s goods or services.”) (quotation omitted); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). We find that SHMIMIC will clearly convey to relevant consumers that applicant’s goods contain mimics featuring molecules forming a small hairpin, consistent with applicant’s explanation of the use of the terms “SH” and “MIMIC” in the relevant industry. Because SHMIMIC describes two significant characteristics of applicant’s goods, it is merely descriptive in relation to those goods.

Decision: The examining attorney’s refusal to register applicant’s mark under Section 2(e)(1) of the Trademark Act is affirmed.

¹⁴ *See* Applicant’s Brief at 9.